

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 18-21 and 35-36 are pending in the application. Claims 19-21 and 35 are under consideration. Claim 20 has been amended to correct an informality. Claims 18 and 36 have been withdrawn.

In the outstanding Official Action, the specification was objected to for allegedly introducing new matter into the disclosure. This rejection is traversed.

In particular, the Official Action asked for a clarification as to whether SEQ ID NO: 10 is a sequence disclosed in Figure 6. Applicants note with appreciation the attention to detail in which the Examiner has reviewed the application. Indeed, SEQ ID NO: 10 is a sequence disclosed in Figure 6. Accordingly, applicants respectfully submit that no new matter has been disclosed by introducing SEQ ID NO: 10 into the sequence listing.

The specification was also objected to in light of discrepancies between the sequences shown in the figures and the sequence listing. Applicants confirm that the sequence as set forth in Figure 4 for SEQ ID NO: 2 is correct. Accordingly, the sequence listing filed with the amendment of October 10, 2007 was revised to show the correct sequence. As the sequence was

disclosed correctly in Figure 4, applicants submit that no new matter has been added to the disclosure.

Furthermore, applicants submit herewith a substitute sequence listing wherein SEQ ID NO: 1 is shown as having 1268 nucleotides. The amendment of October 10, 2007 inadvertently included a sequence listing, wherein SEQ ID NO: 1 was shown to have 1265 nucleotides. As Figure 4 correctly shows that SEQ ID NO: 1 has 1268 nucleotides, applicants submit that no new matter has been introduced into the disclosure.

As to the changes to the present specification at page 8 made in the amendment of October 7, 2007, applicants note that the P2 sequence was correctly shown in Figure 3a. Accordingly, applicants amended the specification at page 8 to reflect the correct sequence. As the correct sequence did appear in Figure 3a, applicants submit that no new matter has been added to the disclosure.

The outstanding Official Action also objected to the drawings submitted on October 10, 2007. As noted above, Figure 3a correctly shows the correct P2 sequence. Accordingly, the specification was amended so that it reflects the proper sequence. As the correct sequence was already disclosed, applicants submit that no new matter has been introduced. Indeed, the specification and drawings have only been amended so that they are consistent with each other.

Claims 20-21 were objected to for reciting the phrase "nucleic acid in prokaryotes according to claim 19". However, claims 20-21 have been amended as suggested by the Examiner. Applicants thank the Examiner for the suggestion as how to overcome the objection.

Claims 19-21 and 35 were rejected under 35 USC 112, first paragraph, for allegedly not satisfying the written description requirement. Applicants believe the present amendment overcomes this rejection.

Applicants submit herewith a new sequence listing which shows SEQ ID NO: 1 as having 1268 nucleotides. Thus, responsive to the concerns of the Examiner, raised in the outstanding Official Action, a substitute sequence listing is provided herewith, attached to the present amendment, in paper and disc formats. Applicants hereby state that the attached paper and computer readable copies have the same content, and introduce no new matter into the present application.

In view of the above, it is respectfully submitted that the above-identified application complies with the requirements for patent applications containing nucleotide sequences and/or amino acid sequence disclosures.

Claims 19-20 were rejected under 35 USC 102(e) as allegedly being anticipated by LANEVE et al. This rejection is traversed.

As noted in the amendment of October 10, 2007, the publication fails to qualify as prior art. Thus, applicants

respectfully submit that the rejection as discussed in the Office Action mailed on April 10, 2007 is no longer relevant.

The rejection of Claim 19 under 35 USC 102(b) as allegedly being anticipated by LANEVE, P. (Purificazione e caratterizzazione di una nuova attivita endoribonucleolitica nella biosintesi dei piccolo RNA nucleolari iln *X. laevis*, Thesis, 2001) GenBank AJ507315 was withdrawn.

However, the Official Action stated that if SEQ ID NO: 1 was amended to include nucleotides CAA, the rejection would be reinstated.

However, applicants respectfully submit that the outstanding Official Action fails to satisfy its burden in showing that this reference qualifies as prior art. The thesis was presented at a university in Italy by P. LANEVE. Thus, the invention was not patented or described in a printed publication in this country or foreign country, or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Indeed, the reference is correctly identified in the International search report as an "O" reference. An O reference is a document referring to an oral disclosure, use, exhibition or other means.

While the outstanding Official Action cites to the GenBank entry, the GenBank entry was not made until September 5, 2002. As a result, the GenBank entry, published later than the priority

date for the present application, does not constitute evidence that the thesis qualifies as prior art under 35 USC 102.

In this regard, applicants respectfully submit that it would be improper to reinstate the rejection.

The Official Action also noted that claim 21 was rejected under 35 USC 103(a) as allegedly being unpatentable over LANEVE et al. It is also noted that claims 20-21 were rejected under 35 USC 103(a) as allegedly being unpatentable LAVENE P.

However, as noted above, neither of these publications qualifies as prior art. Accordingly, applicants respectfully submit that it would also be improper to reinstate or maintain either of these rejections.

At this time, applicants respectfully request rejoinder of claims 18 and 36. The Official Action has withdrawn these claims as being directed an originally presented but non-elected invention. However, the initial lack of unity determination set forth in the Official Action of January 30, 3007 imposed a requirement wherein group I was drawn to nucleic acids and group II was drawn to peptides comprising SEQ ID NO: 2. While claims 18 and 36 are directed to a protein, applicants note that the claims recite that the protein is encoded by a nucleic acid comprising SEQ ID NO: 1. In that all of the pending claims recite SEQ ID NO: 1, it cannot be said that the claims lack unity. Indeed, it is believed that all of the claims relate to

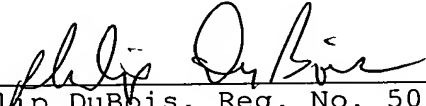
the nucleic acid. Thus, applicants respectfully request for the rejoinder of claims 18 and 36.

In view of the present amendment and foregoing Remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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**APPENDIX:**

The Appendix includes the following item(s):

- ☒ - Sequence Listing in paper and disk formats